

Remarks

The Office Action mailed December 5, 2008, has been received and carefully reviewed. The preceding amendments and the following remarks form a full and complete response thereto. Independent claims 1, 9, 39 and 48 are amended to more clearly recite the claimed subject matter. Support for the amendments can be found, *inter alia*, paragraphs 0018 and 0126 of the originally filed specification. No new matter is added. Accordingly, claims 1-5, 9-12, 39, 48, 59, 62-63 and 76 are pending in the application, and are submitted for reconsideration.

Claims 1-3, 9, 39, 48 and 76 were rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent Publication No. 2002/0044313 issued to Menz et al., now U.S. Patent 6,876,472 (hereinafter "Menz"). The Applicants respectfully traverse the rejection and submit that Menz fails to disclose each and every element of the present invention defined by claims 1-3, 9, 39, 48 and 76.

Independent claim 1, on which claims 2-3 and 76 depend, is directed to a security element, which has at least one area with a diffraction structure embossed during an embossing process with an embossing die. The at least one area reconstructs a diffractive image under specific viewing conditions. The area also has subareas. Independent claim 1 is further amended to recite that at least one of the subareas is produced during the embossing process with the embossing die already providing the at least one subarea which is free of any diffraction structures. The subareas do not take part in the reconstruction of the diffractive image, and which

represent a recognizable information. The information represented by the subareas is recognizable substantially only under the specific viewing conditions.

Menz is directed to an optical feature, in particular for documents of value, having at least one dual-channel hologram for the holographic reconstruction of different images from different directions of gaze. According to Menz, different regions of the hologram are associated with the different channels and the regions of the hologram reconstructing the respective image under incident light have sub-regions which do not take part in the image reconstruction.

Menz fails to disclose a subarea which is created during the embossing process for embossing the diffracting structure with the embossing die. To the contrary, Menz discloses in several passages a subsequent creation of subareas. In particular, Menz's sub-regions are partly destroyed (paragraph 0017) after the sub-regions have been created, or obtained by overprinting (paragraph 0019) or laser impact (paragraph 0028). Overall, Menz's method is carried out by first fully completing the multi-channel hologram and subsequently modifying the optical properties of the corresponding sub-regions, or by recording the first one channel of hologram with a suitable masking and, directly subsequently thereto, modifying the optical properties of the regions belonging to the channel. Menz, paragraph 0044. See also Menz, paragraphs 0054 and 0061.

Since Menz fails to disclose each and every element of claim 1, and its dependent claims 2-3 and 76 accordingly, the Examiner's rejection to claims 1-3 and 76 on the ground of alleged anticipation is improper. The Applicants thus request that the

rejection to claims 1-3 and 76 based on alleged anticipation be withdrawn and the claims be allowed.

Claims 9, 39 and 48 have been amended similarly to claim 1, and thus are allowable over Menz at least for the reasons above.

Claims 4-5, 10-12, 59 and 62-63 were rejected under 35 U.S.C. § 103(a) as being obvious over Menz in view of published U.S. Patent Application No. 2002/0191234 to Ishimoto et al. ("Ishimoto"). The Applicants respectfully traverse the rejection on the basis that the cited prior art, taken singly or in combination, fails to disclose or suggest each and every feature of the claimed invention. Ishimoto fails to cure the deficiencies of Menz, because Ishimoto is merely directed to a laminate which prevents reuse of holograms. Ishimoto, abstract.

Moreover, Applicants would like to point out that it is not sufficient that a skilled person simply replaces the creation of the subareas via overprinting/laser impact according to Menz by a subsequent embossing process in order to arrive at the subject of the amended claims. Since the amended independent claims now define a simultaneous creation of the diffraction structure and the subareas thereof at the same time, a skilled person would have to modify the embossing process already existing in Menz fundamentally in order to avoid the subsequent creation of the subareas. This is, however, not disclosed in Menz. On the contrary, the claimed subject matter is taught away by Menz, which aims at a subsequent modification of the Hologram in order to

make a subsequent individualization of the hologram possible. Menz, paragraph 0061.

For this separate and independent reason, the rejection is improper.

The combination of Ishimoto and Menz fails to disclose or suggest each and every element of independent claims 1 and 9, from which claims 4-5 and 59; and 10-12 and 62-63 depend, respectively. The Applicants thus submit that this rejection has been overcome, and request allowance of claims 4-5, 10-12, 59 and 62-63.

Claims 1-3, 9 and 76 were rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1 and 13 of U.S. Patent No. 6,876,472. Applicants respectfully traverse. Applicants have amended claim 1, from which claims 2-3 and 76 depend, to recite the feature that "at least one of the subareas is produced during the embossing process." Claim 9 has been similarly amended. This claim feature is patentably distinct from the claims of U.S. Patent No. 6,876,472.

In view of the foregoing, all objections and rejections have been sufficiently addressed. The Applicants submit that the application is now in condition for allowance and request that claims 1-5, 9-12, 39, 48, 59, 62-63 and 76 be allowed and this application passed to issue.

In the event that this paper is not timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, the Applicants' undersigned attorney at the indicated telephone number to
arrange for an interview to expedite the disposition of this application.

Respectfully submitted,

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Date

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